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Paper No.

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JUL 08 2004

In re Application of : **OFFICE OF PETITIONS**  
Diaz et al. :  
Application No. 10/757,948 : DECISION DISMISSING  
Filed: January 14, 2004 : PETITION  
Attorney Docket No. 112803.RTI :  
:

This is a decision on the "PETITION TO CORRECT FILING DATE UNDER 37 CFR § 1.53 AND § 1.17(h)," filed June 17, 2004, requesting that the above-identified application be accorded a filing date of December 18, 2003, rather than the presently accorded filing date of January 14, 2004.

Petitioner asserts that December 18, 2003 is the date that applicant made delivery of the complete application materials to the Patent Office. Petitioner states that applicant, acting in a *pro se* capacity, sent the application papers by Federal Express on December 17, 2003. Applicant sought to claim the benefit of the priority of provisional application No. 60/434,128 filed December 18, 2002. In support thereof, petitioner submits the statement of co-inventor Cesar Diaz and copies of 2 Federal Express Airbills. In his statement, inventor Diaz states that

"It appears that Federal Express Added MS17, Office of Finance to the address and this caused confusion in your office."

Inventor Diaz implies that this confusion led to the application papers being refused by the USPTO and returned to him. (However, petitioner acknowledges that it is not entirely apparent why the package was returned.)

Petitioner submits no postcard receipt or other evidence of receipt or refusal of the Federal Express package by the USPTO.

**RELEVANT STATUTE, REGULATION AND NOTICES**

35 U.S.C. 111(a)(4), provides, in pertinent part:

The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

§ 1.6 Receipt of correspondence.

- (a) Date of receipt and Express Mail date of deposit.

Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

§ 1.10 Filing of papers and fees by "Express Mail."

(a) Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date. See § 1.6(a).

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that ...

However, as stated in MPEP 512:

The benefits of ... 37 CFR 1.10 apply only to documents delivered to the Office by the U.S. Postal Service.

**ANALYSIS**

Petitioner's arguments and evidence have been considered, but not found persuasive that the application is entitled to a filing date other than January 14, 2004, the date of receipt of the application papers in the Office.

The gravamen of petitioner's argument is that the application papers were "delivered" to the Office on December 18, 2003, but refused by the USPTO. However, petitioner has not shown that the application papers were, in fact, received in the USPTO on

December 18, 2003. The FedEx Airbill label is insufficient to establish deposit of the application papers in the USPTO. Petitioner has no postcard receipt, indicating acceptance (or presentation) of the papers in the USPTO on December 18, 2003.

Nor does the evidence show that the package was refused by the USPTO. There is no direct evidence of refusal by the USPTO. As "MS17, Office of Finance" is a mail stop address within the USPTO, the addition of this information on the FedEx mail label does not necessarily explain any refusal of the package by the USPTO. Petitioner speculates that the package was refused by the USPTO. However, error on the part of FedEx in delivering the package is not precluded.

Unfortunately, where an error occurs in the Express Mail delivery of a package, an applicant is only protected when they have deposited their papers via the United States Postal Service pursuant to § 1.10. To establish that a paper not entitled to the benefit of a certificate of mailing under 37 CFR 1.8(a)<sup>1</sup> was filed (or attempted to be filed) in the USPTO, applicant must have used Express Mail and complied with the provisions of 37 CFR 1.10, or have a postcard receipt establishing that the paper was actually received in the USPTO (and later misplaced). Complying with the provisions of 37 CFR 1.10 requires that the application papers be sent via deposit in the "Express Mail Post Office to Addressee" service of the United States Postal Service. It is well-established that the benefits of § 1.10 apply only to documents delivered to the Office by the U.S. Postal Service. See MPEP 512. Documents hand-carried or delivered to the Office via commercial couriers, e.g., "Federal Express," "DHL," "Purolator," "Air Borne," "UPS" are not entitled to the benefit of § 1.10. The filing date of papers delivered via commercial couriers is the date of receipt, pursuant to § 1.6. Other than via § 1.10 or postcard evidence, the rules do not provide a mechanism for establishing that such application papers were filed (or attempted to be filed) in the USPTO.

Petitioner acknowledges that the application as originally filed was not filed by way of deposit with the United States Postal Service. Accordingly, pursuant to 37 CFR § 1.6 and 35 U.S.C. 111, the application as originally filed is entitled to the date of receipt of the specification and drawings as the filing date. The date petitioner maintains the application papers were originally sent via Federal Express is not dispositive.

#### CONCLUSION

Accordingly, the petition must be **dismissed**.

Any request for reconsideration must be filed within **TWO (2) MONTHS** of the date of this decision in order to be considered timely. See 37 CFR 1.181(f). This time period may not be extended pursuant to 37 CFR 1.136(a) or (b).

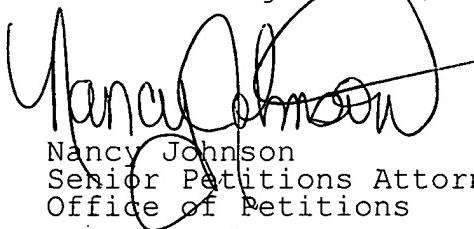
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<sup>1</sup> The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d) is not entitled to the benefits of § 1.8.

There is no indication that the person signing the instant petition was given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

The application with the presently accorded filing date of January 14, 2004, is undergoing preexamination processing.

Telephone inquiries regarding this matter should be directed to the undersigned at (703) 305-0309.



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